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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/041,117	01/08/2002	Donald F. DePalma	CRD0918	4482

27777 7590 02/26/2003

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EXAMINER

MILLER, CHERYL L

ART UNIT	PAPER NUMBER
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3738

DATE MAILED: 02/26/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

10/041,117

Applicant(s)

DEPALMA ET AL.

Examiner

Cheryl Miller

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 08 January 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-18 is/are pending in the application.
- 4a) Of the above claim(s) 17 and 18 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-16 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) 1-18 are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 3.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

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## DETAILED ACTION

### *Election/Restrictions*

This application contains claims directed to the following patentably distinct species of the claimed invention: different species drawn to Figures 1, 2, 8, and 9.

Applicant is required under 35 U.S.C. 121 to elect a single disclosed species for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable. Currently, no claims are generic.

Applicant is advised that a reply to this requirement must include an identification of the species that is elected consonant with this requirement, and a listing of all claims readable thereon, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered nonresponsive unless accompanied by an election.

Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations of an allowed generic claim as provided by 37 CFR 1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species. MPEP § 809.02(a).

Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

During a telephone conversation with Carl Evans (registration no. 33,874) on February 19, 2003 a provisional election was made without traverse to prosecute the invention of Figure 1, claims 1-16. Affirmation of this election must be made by applicant in replying to this Office

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action. Claims 17-18 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

#### ***Information Disclosure Statement***

The information disclosure statement filed on March 15, 2002 does not fully comply with the requirements of 37 CFR 1.98 because: pages 1-28 of the 29 pages are missing. Only page 29 of 29 was found in the application. Since the submission appears to be *bona fide*, applicant is given **ONE (1) MONTH** from the date of this notice to supply the above mentioned omissions or corrections in the information disclosure statement. **NO EXTENSION OF THIS TIME LIMIT MAY BE GRANTED UNDER EITHER 37 CFR 1.136(a) OR (b).** Failure to timely comply with this notice will result in the above mentioned information disclosure statement being placed in the application file with the noncomplying information **not** being considered. See 37 CFR 1.97(i).

#### ***Specification***

The abstract of the disclosure is objected to because it contains the legal terminology "the present invention", which is improper and should be modified. Correction is required. See MPEP § 608.01(b).

Applicant is reminded of the proper language and format for an abstract of the disclosure.

The abstract should be in narrative form and generally limited to a single paragraph on a separate sheet within the range of 50 to 150 words. It is important that the abstract not exceed 150 words in length since the space provided for the abstract on the computer tape used by the

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printer is limited. The form and legal phraseology often used in patent claims, such as "means" and "said," should be avoided. The abstract should describe the disclosure sufficiently to assist readers in deciding whether there is a need for consulting the full patent text for details.

The language should be clear and concise and should not repeat information given in the title. It should avoid using phrases which can be implied, such as, "The disclosure concerns," "The disclosure defined by this invention," "The disclosure describes," etc.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

Claims 1-16 are rejected under 35 U.S.C. 102(e) as being anticipated by Kujawski (USPN 6,306,164 B1, cited by applicant in IDS). Kujawski discloses a system (10) for bypassing an aneurysm (col.3, lines 1-3) comprising a first prosthesis (12) defining a first fluid path and two second prosthesis (30, 32) communicating with the first prosthesis, wherein the first prosthesis comprises a proximal end configured to engage a section upstream of an aneurysm (fig.4) and the second prosthesis configured to bypass the aneurysm and anchor in a downstream artery (fig.4). Kujawski discloses the first prosthesis (12) comprising a stent (18) and a graft (20) defining a fluid flow path. Kujawski discloses the first prosthesis comprising a gasket configured to receive the two second prostheses (col.3, lines 14-35). Kujawski discloses the first prosthesis adapted to conform to the shape of the artery, having a flexible intermediate portion and comprising a manifold configured to receive a second prosthesis and split the fluid path into two fluid paths (16a, 16b). Kujawski discloses the second prosthesis comprising a stent and graft defining a fluid path (col.9, lines 4-6), which bypasses an aneurysm. Kujawski

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discloses a method for bypassing an aneurysm comprising positioning a first prosthesis upstream of an aneurysm, positioning a second prosthesis distal of the first prosthesis, engaging the second prostheses (30, 32) with a receptacle (16a, 16b) of the first prosthesis (12), and expanding the first and second prosthesis forming a fluid tight seal between the two prostheses (col.3, lines 14-35; col.9, lines 27-48).

Claims 1-16 are rejected under 35 U.S.C. 102(b) as being anticipated by Dereume et al. (USPN 5,639,278). Dereume discloses a system for bypassing an aneurysm (see figures 18-28, example 3, and respective portions of the specification) comprising a first prosthesis (101) defining a first fluid path and two second prosthesis (108, 115) communicating with the first prosthesis (101), wherein the first prosthesis (101) comprises a proximal end configured to engage a section upstream of an aneurysm (103) and the second prostheses (108, 115) configured to bypass the aneurysm (103) and anchor in a downstream artery (110, 112). Dereume discloses the first prosthesis (101) comprising a stent (121) and a graft (122) defining a fluid flow path. Dereume discloses the first prosthesis comprising a gasket (119) configured to receive the two second prosthesis (108, 115). Dereume discloses the first prosthesis adapted to conform to the shape of the artery (fig.19), having a flexible intermediate portion and comprising a manifold configured to receive a second prosthesis and split the fluid path into two fluid paths (26, 27). Dereume discloses the second prosthesis comprising a stent and graft defining a fluid path, which bypasses an aneurysm (example 3). Dereume discloses a method for bypassing an aneurysm comprising positioning a first prosthesis upstream of an aneurysm (fig.18, 19), positioning a second prosthesis distal of the first prosthesis and engaging the second prosthesis with a receptacle of the first prosthesis (fig.21-24), expanding the first and second prosthesis forming a fluid tight seal between the two prostheses (fig.24, 25).

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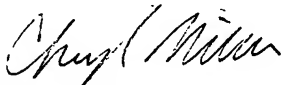
**Conclusion**

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Cheryl Miller whose telephone number is (703) 305-2812. The examiner can normally be reached on Monday through Friday from 7:30 am to 5:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Corrine McDermott, can be reached on (703) 308-2111. The fax phone number for the organization where this application or proceeding is assigned is (703) 305-9560.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0661.



Cheryl Miller

February 21, 2003



BRUCE SNOW  
PRIMARY EXAMINER